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10/065,120	09/18/2002	Scott C. Harris	GPSPrivC1	8217

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SCOTT C HARRIS  
P O BOX 927649  
SAN DIEGO, CA 92192

EXAMINER

BLUM, THEODORE M

ART UNIT PAPER NUMBER

3662

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/065,120

Applicant(s)

HARRIS, SCOTT C.

Examiner

Theodore M. Blum

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 37-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other:

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1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

✓ Claim 36 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 12 of prior U.S. Patent No. 6,473,031. This is a double patenting rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

✓ 3. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart. Stewart teaches the claimed method and structure for operating an electronic device including: GPS position detection module (40), cellular telephone (Figure 2), manual override control switch (42, column 8, line 62 to column 9, line 15) which is actuated to prevent said position detection module from reporting information about its position, but which allows other parts of said electronic device to operate, and optical indicator (43) which indicated the position of the manual override control switch (42, column 5, lines 38-40) and as a result, that a privacy enhanced mode has been entered.

Lines 5-10 in column 9 of Stewart state "Bypass switch 42 can further also allows the user to completely deactivate background operation so that received incoming calls carrying only a location request code will be automatically disconnected without GPS location detector 40 providing a location signal".

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

X 5. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiple et al in view of Ohyama et al.

Seiple et al teaches the claimed method and structure for operating an electronic device including: position detection module (Figure 2A), transceiver (21), override control (switch 30, Figure 3.5, column 4, lines 60-65, column 5, lines 22-24, column 7, lines 37-46, and column 10, lines 31-38) which is actuated to prevent said position detection module from reporting information about its position, but which allows other parts of said electronic device to operate.

Ohyama et al teaches a manual switch (103 in Figure 17, and column 13, lines 28-32) to place the electronic apparatus in a sleep mode.

At any time, to save power used by the electronic device, obviously the GPS receiver of Seiple et al can be placed in the sleep mode (column 7, lines 37-44 of Seiple et al) by a manual switch as taught by sleep mode switch 103 of Ohyama et al (column 13, lines 28-32).

To use the transceiver (21) of Seiple et al in a large number of locations, obviously the transceiver of Seiple et al can be the cellular type.

Figures 3.2-3.5 of Seiple et al indicate that the GPS subsystem and the Radio receiver subsystem can be turned on or off independently from each other.

✓ 6. Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Yee et al.

Yee et al teaches the claimed method and structure for operating an electronic device including: position detection module (14), cellular telephone (column 5, lines 51-61), override control (column 2, lines 51 to column 3, line 4, and column 11, line 67 to column 12, line 12) which prevents said position detection module from reporting information about its position, but which allows other parts of said electronic device to operate.

✓ 7. Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Krasner.

Krasner teaches the claimed method and structure for operating an electronic device including: position detection module (130), cellular telephone (109), override control (column 4, lines 38-43 and column 10, lines 23-26) which is actuated to prevent said position detection module from reporting information about its position, but which allows other parts of said electronic device to operate. Krasner further teaches testing device (160), which tests whether, said automatic reporting is operating.

Krasner further teaches actuating mechanism (104), which produces a signal (110), which prevents the position detection module from reporting information about its position. The signal received from the system of Krasner will inherently provide testing of the system.

✓ 8. Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Herring.

Herring teaches the claimed method and structure for operating an electronic device including: position detection module (20), cellular telephone (14), override control (column 5, lines 17-19) which is actuated to prevent said position detection module from reporting information about its position, but which allows other parts of said electronic device to operate. Herring further teaches testing device (100 and 200), which tests whether, said automatic reporting is operating.

Herring further teaches actuating mechanism (16), which produces a signal, which prevents the position detection module from reporting information about its position. The signal received from the system of Herring will inherently provide testing of the system.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore M. Blum whose telephone number is 703-305-1833. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on 703-306-4171. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Theodore M. Blum  
Primary Examiner  
Art Unit 3662